

REMARKS

This amendment is responsive to the Office Action of December 6, 1999.

As such, a request for a three-month extension of time and the appropriate fee are enclosed.

Claims 1, 2, 5, 7, 8, 15-17, 20, and 39-55 are now pending. Claims 1 and 47 are the only independent claims. Applicants respectfully request reconsideration and allowance based on the above amendments and following remarks.

As discussed further below, the Applicants' invention involves a unique method of incorporating a decorative enhancement composition onto the surface of a polyethylene article and then heating that composition in order to permanently fuse it into the article. The present application discloses an embodiment where the composition is incorporated into the article's surface after it has been removed from the mold. Applicant seeks to claim priority from application 08/566906 that discloses an embodiment where the composition is incorporated into the article's surface while it is in and before it is removed from the mold. Priority is appropriate because the base claims are broad enough to cover both embodiments (there being no timing requirement) and because the broadened claims are supported by both this application and by 08/566906.

1. Section 112, First Paragraph Issues

At paragraph 1, the Office Action rejects some of the pending claims as indefinite under Section 112, second paragraph. Applicant has resolved these minor issues by:

A) amending Claim 1 and Claim 47 to require a "surface color" rather than a "*desired surface color*",

B) by amending Claim 2 to read as follows:

2. (Twice Amended) The method of Claim 39
wherein said liquid carrier comprises 60 to 90 weight percent
of said decorative enhancement composition [for use in
~~applying]~~ in order to provide said decorative enhancement
composition with a consistency and viscosity suitable for
application by spray methods.; and

C) by amending the transitional phrase in the preamble of independent Claim 47 to state that the method "comprises the steps of:" so that there is an antecedent basis for the term "steps" in dependent Claims 40, 41, 49 and 50.

At paragraph 2, the Office Action rejects all of the pending claims as indefinite because the instructions in the amendment filed on 3/16/99 are not clear. as As explained in the last amendment, Applicants' attorney accidentally referenced line 28, when he meant line 29. Applicants have herein deleted the original instructions directed to line 28 by asking that it be disregarded.

The Examiner is thanked for her thorough review of the case and is invited to telephone the undersigned attorney if any further 112 issues become apparent.

2. Enablement/New Matter Issues

At paragraphs 3 and 4, the Office Action suggests that the specification does not enable the composition of amended Claim 1 or new Claim 47¹. In particular, the Office Action asserts that the original application does not describe three specific claim elements that are presently regarded as new matter.

Applicants respectfully submit that enabling support can be found in the original specification as follows:

(1) Claim 1: "...powder in an amount sufficient to fuse into and form a permanent bond with the molded polyethylene article...:

Applicants respectfully direct the Examiner to pages 9 and 17 of the original specification where literal support for this language can be found:

Page 9:

Once heated, the ... decorative enhancement compositions become incorporated into the surface of the polyolefin, presumably by fusion at the interface of the coatings and the polyolefin surface... forming a permanent bond between the coatings and the polyolefin surface. (9:29-35, emphasis added).

Page 17:

... the colored thermoplastic [is adhered] to the polyethylene surface until it can be bonded [i.e. fused]... (17: 6-8).

¹ The Applicants disclosed percentages in their original specification in order to fully disclose their preferred embodiment and they recited those percentages in the original claims. Applicants believe that they are entitled to remove the percentage limitations and otherwise broaden the claims in order to claim priority to 08/566906, so long as the broadened claims do not read on the prior art. It would be greatly appreciated if the Examiner would comment on this specific issue if she believes otherwise.

(2) Claim 47: "... a binder to provide the decorative enhancement composition with temporary adherence..."

Applicants have resolved this issue by simply amending this language in Claim 47 such that it corresponds exactly with the acceptable language in Claim 1, i.e.

a binder to provide adhesion of the decorative enhancement composition [with temporary adherence] to said polyethylene surface;

(3) Claim 47: "...powder that is adapted to fuse into and form a permanent bond with the molded polyethylene article."

Claim 47 intentionally omits the "in an amount sufficient to" modifier found in Claim 1, but otherwise the above remarks showing that the original specification provides enabling support for similar language in Claim 1 apply here as well.

3. Claim Objections

At paragraph 5, the Examiner notes that Claims 1, 46 and 55 lack periods. The claims have been suitably amended above.

4. Priority Claim

The truly fundamental issue in this case is whether or not Applicants can claim priority to 08/566906 under 35 U.S.C. 120 which provides in relevant part that:

An application for patent for an invention disclosed in the manner provided by the first paragraph of Section 112 of this title in an application previously filed, ... which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application...

When a priority claim is made under Section 120, the only issue are (1) was there copendency and (2) does the parent application provide support for the invention as claimed.

There are differences in the embodiments of this application and of 08/566906, but it is important to focus on the claimed invention and not diverge into differences that are immaterial to the claims. The priority analysis, in other words, should be governed only by what is required by independent Claims 1 and 47.

Since there is no issue regarding copendency, the only inquiry under Section 120 is, "Does the parent application disclose what is claimed"? The answer here is "yes", in that the parent application discloses everything that is required by Claims 1 and 47.

In particular, the parent application clearly discloses the steps (paraphrased) of:

- (1) "incorporating"² a decorative enhancement composition" to the surface of a molded article, where such composition³ consists essentially of
 - a liquid carrier,
 - a colorant,
 - a binder, and
 - a thermoplastic powder; and
- (2) "heating"⁴ the composition and the molded article to produce a molded article having a permanent decoratively enhanced surface characterized by a colorant on and in said surface.

The Office Action refuses the priority claim by asserting that the "in-mold" parent case is "*different*" from this "on-part" case, as follows:

The present application is not entitled to the filing date of 08/566906 because the present application recites a coating composition and process (20-90 percent liquid carrier, 9-50% colorant + 50-91% of binder and particulate thermoplastic powder), to be applied to a molded article) that is different from that of 08/566906 (thermoplastic or thermosetting resin, liquid carrier, binder solid, and optional colorant, to be applied to a mold surface).

See MPEP 201.11.

Applicants readily concede that the preferred embodiment in the parent application is an in-mold process. In particular, the enhancement composition is incorporated to a PE surface inside while the PE part is in the mold.

² The "incorporating" step is purposely silent on timing such that it covers any incorporating, both pre-mold and post-mold.

³ The "composition" is purposely claimed without regard to percentages such that it covers any percentage.

⁴ The "heating" step, like the incorporating step, is silent as to timing such that it covers any heating regardless of whether it occurs pre-mold or post-mold.

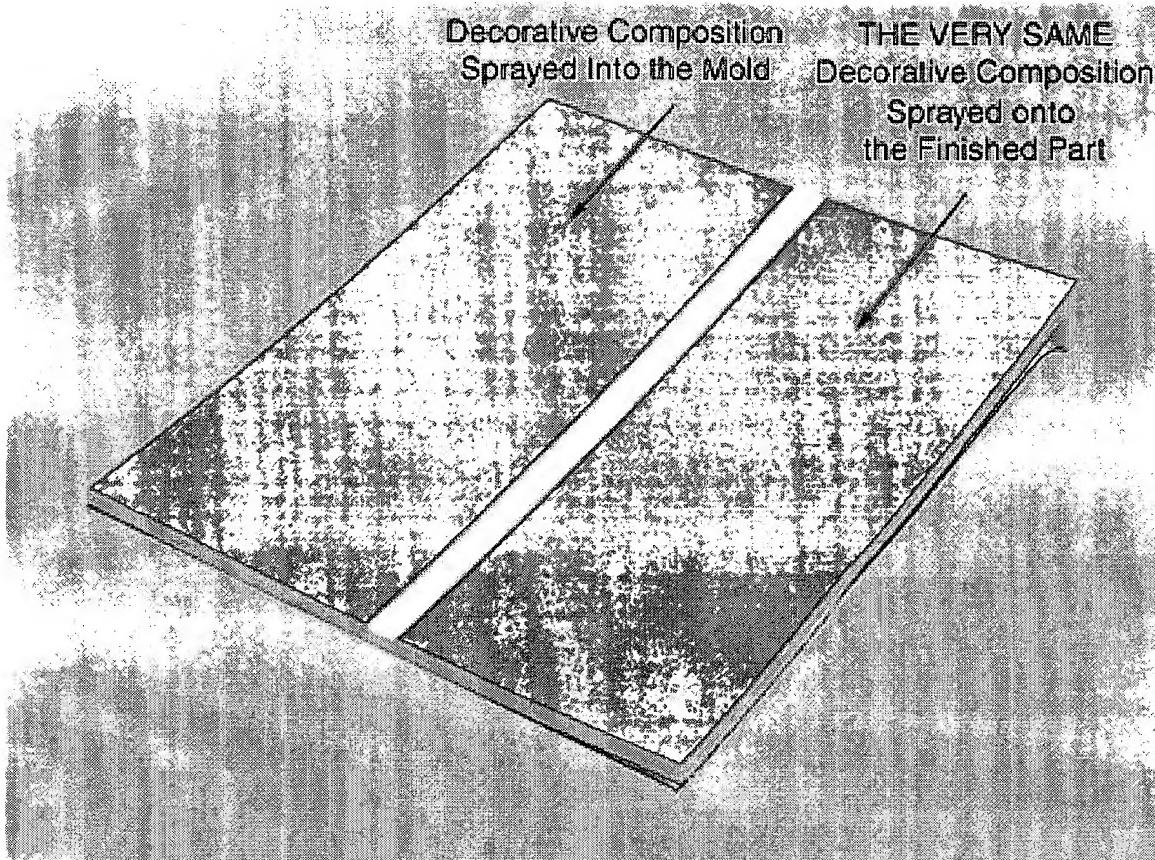
Applicants similarly concede that the preferred embodiment in this application is a post-mold process. In particular, the enhancement composition is incorporated to the PE surface after removing the PE part from the mold.

These differences, however, speak only to the timing of the incorporation. Timing is not part of Claims 1 or 47 and differences in timing cannot be the basis for refusing to allow Applicants's priority claim to the parent application under 35 U.S.C. 120.

In summary, Applicants respectfully submit that the Office Action is improperly relying on differences between the two applications that are not claimed. There are often identifiable differences between a parent and child application. Such differences are not meaningful to the issue of priority, however, if they are unrelated to the claim under consideration. In this case, in particular:

- The parent application's disclosure of incorporating the composition to the surface by first applying the composition to the mold is completely irrelevant to Applicant's priority claim because Claim 1 is completely silent as to the timing of its incorporation step; and
- The parent application's disclosure of different ingredient percentages is completely irrelevant to Applicant's priority claim because Claim 1 is completely silent as to any ingredient percentages.

The following polyethylene article was created to help explain why this application is entitled to the filing date of 08/566906.



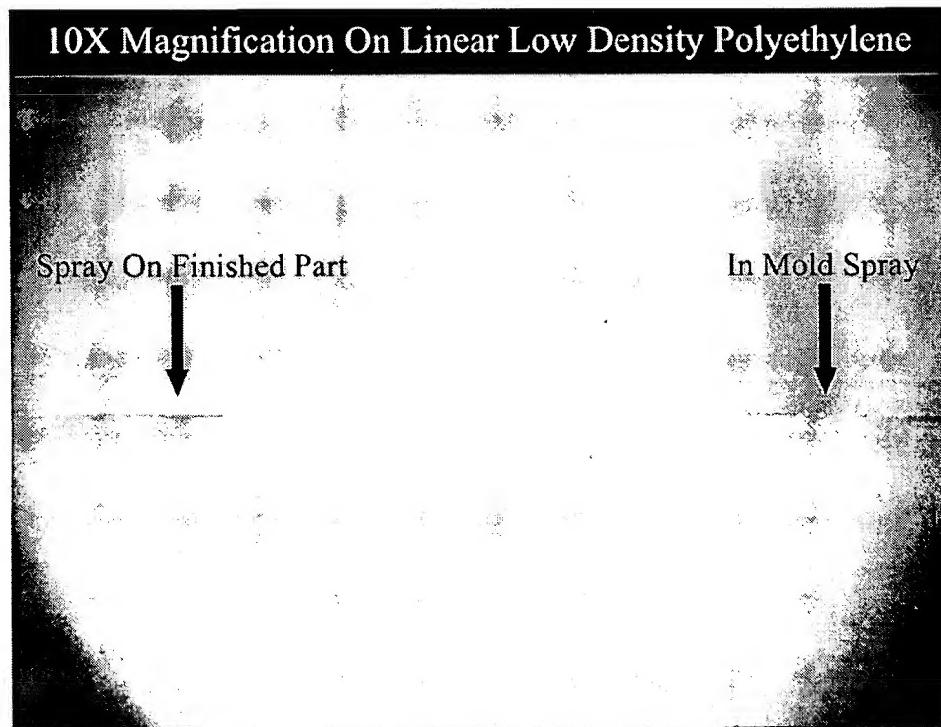
As shown above, the inventors practiced the claimed method for permanent decorative enhancement of a molded polyethylene article having a polyethylene surface on two different sides of a polyethylene article and in two different ways. The first way was an “in-mold” process like the preferred embodiment disclosed in priority application 08/566906. The second way was an “on-part” process like the preferred embodiment disclosed in this application. Both ways, however, are clearly covered by Claims 1 and 47.

In fact, the decorative enhancement composition used on both sides quite literally came from the same spray can. The only difference between the two sides of

the article was the timing of application. The timing of the incorporating step, however, forms absolutely no part of the claimed invention.

On the left side, the decorative enhancement composition was incorporated to the surface by being sprayed into the mold and then the heat was applied to the composition while the article was inside of the mold. On the right side, the SAME composition was incorporated to the surface by being sprayed onto the article after it was removed from the mold and then the heat was applied with a heat gun. As already noted, Claims 1 and 47 encompass both approaches.

As set forth in Claims 1 and 47, in fact, the result in both cases is a "permanently colored decoratively enhanced surface characterized by colorant that is both on and in the polyethylene surface of said molded polyethylene article (the originals are attached as Exhibit "A"):



The finished results are nearly identical. Both stripes of color look the same from all angles and, as shown above, even at magnification (note the diffusion of colorant into the article that is discussed in both applications). The disclosed technologies are essentially the same and they both meet the claims.

Applicants respectfully submit that this application is entitled to the earlier filing date because 08/566906 provides demonstrative support for the invention as claimed.

5. Summary

Based on the above amendments and accompanying remarks, Applicants respectfully submit that this entire case is in condition for allowance and earnestly solicit a notice to that effect.

The Examiner is encouraged to call the undersigned attorney if it appears that a phone conference, or even an in-person interview, would further this case in any way.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on

June 6, 2000

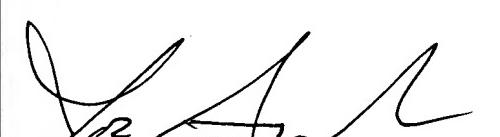
by Eric Hoover



Signature

June 6, 2000

Respectfully submitted,



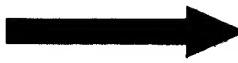
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10X Magnification On Linear Low Density Polyethylene

Spray On Finished Part

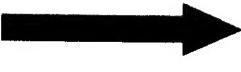


In Mold Spray

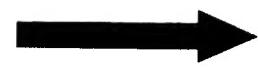


30X Magnification On Linear Low Density Polyethylene

Spray On Finished Part



In Mold Spray



30X Magnification Linear Low Density Polyethylene

Spray On Finished Part



In Mold Spray

